

In response to the Office Action dated April 13, 2004
Amendment/Response dated October 13, 2004

REMARKS

Claims 1-78 are currently pending in this application, with claims 1, 8-11, 13-15, 23-25, 33-35, 43, 52-55, 65-68 and 76-78 in independent form. Claims 13, 23, 33, 43, 52, 54-55, 65, 68 and 76 have been amended herein. Applicants submit that no new matter has been added by way of his amendment. Applicants respectfully request reconsideration in view of the foregoing amendments and the following remarks.

Claim Rejections – 35 U.S.C. § 101

The Office Action indicates that claims 13, 23, 33, 43, 52, 54-55, 65, 68 and 76 have been rejected under 35 U.S.C. § 101 because the claimed invention is directed to allegedly non-statutory subject matter.

Applicants respectfully submit that the amendments to independent claims 13, 23, 33, 43, 52, 54-55, 65, 68 and 76 address this issue. Specifically, the term “on a computer system” has been added to further clarify aspects of the invention within the technological arts. Accordingly, Applicants request withdrawal of this ground of rejection.

Claim Rejections – 35 U.S.C. § 103

1. Claims 1-10, 12, 16-22, 26-32 and 36-42 have been rejected under 35 U.S.C. §103(a), as allegedly being unpatentable over Joao (U.S. Pat. No. 6,347,302), in view of Borghesi, et al. (U.S. Pat. No. 5,950,169). Applicants submit that in the pending Office Action, the Examiner has characterized five arguments that the Applicants have made and provides a

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corresponding response section (“A” through “E”) for each. (See, Office Action, pages 33-42).

However, as will be discussed below, Applicants submit that the response sections appear to contradict the Examiner’s rejections made in the pending Office Action. Moreover, Applicants submit that the statements made in sections “A” through “E” also do not appear to address the issues raised by the Applicants in the Amendment and Response dated December 23, 2004.

Therefore, Applicants respectfully traverse the rejections and request reconsideration in view of the following remarks.

Independent claim 1 recites, *inter alia*, “calculating a periodic recurring amount based on the insurance premium, the financial balance and the predetermined time; and receiving, from the buyer, a single payment...[of the] periodic recurring amount within the predetermined time.” Applicants respectfully submit that neither Joao nor Borghesi, taken either alone or in combination, teaches or suggests at least calculating a periodic recurring amount based on the insurance premium, the financial balance, and the predetermined time.

In sections “A”- “C”, the Examiner responds to Applicants’ arguments that Joao, nor Borghesi teach or suggest the claimed “calculating a periodic recurring amount...” element (See, Office Action on pages 34-37). In sections “A” and “C” the Examiner quotes the text of Joao, Col. 5, lines 47-Col. 6, line 65 and alleges the Joao’s text “correspond[s] to the Applicant’s claimed feature.” However, in the Office Action, the Examiner concedes, “Joao does not explicitly disclose calculating a periodic recurring amount based on the insurance premium, the financial balance and the predetermined time; and receiving, from the buyer a single payment corresponding to the periodic recurring amount with the predetermined time.” (See, pending

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Office Action page 5, ¶1, and July 1, 2003 Office Action, page 4, ¶2)(emphasis added).

Applicants respectfully submit that the statements in section “A” of the Office Action appear to contradict, the acknowledgement on page 5, ¶ 1 that Joao does not teach the claimed element.

Moreover, the cited passage in Joao does not support the allegation that Joao’s text “correspond[s] to the Applicant’s claimed feature.” The cited passage lists various hardware modules including a database 7 in Joao’s system. The passage also discusses various data entries that may be stored in the database related to “residential and/or commercial property,” as well as “data and/or information related to vehicle leases,” wherein the date entries range from “vehicle year” and “vehicle model” data to “probability of post-warranty repairs necessitated by wear and tear.” The data entries discussed therein are used to achieve the primary goal of Joao’s system, “to facilitate the calculation...of an insurance policy... for providing extended warranty protection for any leased and/or rented entity....” (See, Joao, Col. 5, lines 47-Col. 6 line 65) (emphasis added). However, the passage cited in Joao does not disclose, teach or suggest the claimed, “calculating on a computer system a periodic recurring amount based on the insurance premium, the financial balance and the predetermined time” as recited in independent claim 1.

In the section “B” of the pending Office Action, the Examiner alleges that “he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art....” (See, Office Action, page 37, ¶ 2). Applicants respectfully disagree and submit that neither Joao, nor Borghesi teach or

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suggest the claimed “calculating a periodic recurring amount...” element and therefore a prima facie case of obviousness has not been established.

The Examiner’s assertion that a prima facie case of obviousness has been made is improper – the Examiner has not provided a teaching or suggestion of the claimed element within Joao or Borghesi. More specifically, Applicants submit Borghesi does not teach or suggest anything that remedies the deficiency identified in Joao, with regard to the claim element.

As discussed in the Amendment and Response dated December 23, 2003, Borghesi is directed to a computer database system for managing insurance claim processing. Borghesi contains event log steps for interacting with a graphical user interface associated with an event log, which in turn “is useful both for appraisers/adjusters and insurance company managers to monitor claim processing efficiency.” (See, Col. 15, lines 8-23 and 30-32). Accordingly, Applicants respectfully submit that Borghesi’s database for claim processing management does not teach or suggest at least “calculating a periodic recurring amount based on the insurance premium, the financial balance and the predetermined time...” as recited in independent claim 1.

With regard to independent claims 8, 9 and 10, the Examiner concedes that Joao omits at least an element of each respective claim. Accordingly, the Examiner asserts that the passages in Borghesi’s columns 1, 15 and 16 remedy the deficiencies of Joao, with regard to independent claims 8, 9, and 10. However, as clearly discussed in pages 24-29 of the December 24, 2003 Amendment, Borghesi’s system for managing insurance claims does not disclose, teach,

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suggest, or render obvious the claims elements that the Office Action concedes the Joao patent omits. Moreover, in the event the Examiner maintains the rejection based on Borghesi, Applicants request that the sections of Borghesi that remedies these deficiencies be identified.

Accordingly, for at least the reasons discussed above and those discussed in the December 23, 2003 Amendment and Response, Applicants submit that independent claims 1 and 8-10, as well as claims 2-10, 12, 16-22, 26-32, and 36-42, are patentably distinct from both Joao and Borghesi, taken alone or in combination. Therefore, Applicants respectfully request withdrawal of these grounds of rejections.

2. Claims 11, 13-15, 23-25, 33-35, 43-51 and 52-78 have been rejected under 35 U.S.C. § 103(a) as being allegedly being unpatentable over Joao, in view of Ryan (U.S. Pat. No. 6,304,859). The Applicants respectfully disagree with the Examiner's response to the Applicants' traversal based on Joao and Ryan (See, Office Action, page 39-40, sections "D" and "E").

In section "D" in the Office Action, the Examiner relies solely on Joao's teachings to allegedly "correspond to Applicant's claimed feature" relying on Joao, Col. 8, lines 12-64. Applicants submit that Joao's system "may be utilized to calculate risk, risk of loss and/or damage probabilities for an individual and/or business entity, for any given lease or rental situation." (See, Joao, Col. 8, lines 12-64). However, as discussed in greater detail in the December 23, 2003 Amendment and Response, Joao's calculation of "risk of loss" or "damage probabilities" for a lease does not disclose, teach, suggest or render obvious the elements recited in independent claim 11.

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Independent claim 11 recites, *inter alia*, “the item having a corresponding finance amount and an insurance premium amount, the finance amount corresponding to a loan payment as part of a loan secured for buying the item or a lease payment as part of a lease for the item and payable over a predetermined time, the insurance premium amount corresponding to an insurance policy having a term equal to the predetermined time....” Applicants respectfully submit that neither Joao, nor Ryan teach or suggest a finance amount corresponding to a loan payment as part of a loan obtained for buying the item or a lease payment as part of a lease for leasing the item.

Moreover, the Office Action concedes, “Joao does not explicitly disclose a method for simultaneously paying a financial loan and insurance corresponding to an item; the finance amount corresponding to a loan payment or a lease payment and payable over a predetermined time....” (See, Office Action, page 10, ¶ 2)(emphasis added). Applicants respectfully submit that the statements in section “D” of the Office Action appear to contradict, the acknowledgement on page 10, ¶ 2 that Joao does not teach the claimed element.

In section “E”, the Examiner relies on the Ryan patent as allegedly “corresponding[ing] to the Applicants’ claimed feature” citing Ryan, Col. 9, lines 66-Col. 10, line 36. Applicants submit that the Ryan patent does not remedy Joao’s deficiency. As discussed in the December 23, 2003 Amendment and Response, the system disclosed in the Ryan patent also, “performs the Loan to Cash Value Monitoring Process 5...[in which] the lending institution provides a loan to finance a portion of the variable life insurance premium....” (See, col. 10, lines 15-20). The Ryan patent merely teaches combining a portion of an employee’s own income with a portion of a loan in order to pay an Employee’s life insurance premium.

The Ryan patent does not teach an “item having a corresponding finance amount and an insurance premium amount, the finance amount corresponding to a loan payment as part of a loan secured for buying the item or a lease payment as part of a lease for the item,” as recited in claim 11. Instead, Ryan monitors a loan that is received to obtain a life insurance policy. Accordingly, Applicants submit that Ryan does not disclose, teach, suggest, or render obvious the claimed element.

Therefore, for at least the reasons discussed above and those discussed in the December 23, 2003 Amendment and Response, Applicants submit that independent claim 11 is patentably distinct from the cited references, taken either alone or in combination. For at least similar reasons, Applicants submit the elements of independent claim 13-15, 23-25, 33-35, 43, 52-55, 65-68 or 76-78, as well as the claims 44-51, 56-64 and 69-75, which are dependent on claims 43, 55 and 68, respectively are patentably distinct from the cited references. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been made and request withdrawal of these grounds of rejections.

Applicants have concurrently filed a Request for Continued Examination. Further, Applicants have been in communication with the Examiner and are attempting to schedule an Examiner interview regarding the instant application. Accordingly, Applicants respectfully request that the Examiner delay substantively considering the Amendment and Response until after the Examiner interview has occurred.

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CONCLUSION

It is now believed that all pending claims are in condition for allowance. In view of the amendments and remarks, an early and favorable reconsideration is respectfully requested.

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

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By: Daniel C. Sheridan

Daniel C. Sheridan
Registration No. 53,585

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.
3 World Financial Center
New York, NY 10281-2101
(212) 415-8700 (telephone)
(212) 415-8701 (facsimile)